

## **REMARKS**

Claims 1-25 are pending in this application. Attached hereto is a complete listing of all claims in the application, with their current status listed parenthetically. By this Response, claims 1, 14 and 18 have been amended, and are presented with markings indicating their current amendments. Claims 3 and 19 have been cancelled, and 20-25 have been withdrawn, without prejudice to later prosecution.

### **Restriction Requirement**

Applicant acknowledges with appreciation the courtesies extended by the Examiner to Applicant's prior representative in the telephone conversation of June 3, 2005. During this conversation it appears that the Examiner requested an election between Group I (claims 1-19), and Group II (claims 20-25). It appears that Applicant's prior representative provisionally elected, with traverse, to prosecute the invention of Group I claims.

By this Response, Applicant affirmatively elects Group I (claims 1-19) to be examined. Accordingly, Applicant withdraws claims 20-25 without prejudice as non-elected claims.

However, Applicant expressly reserves his right under 35 U.S.C. § 121 to file one or more divisional or continuation applications directed to the non-elected subject matter during the pendency of this application, or an application claiming the benefit of this application under 35 U.S.C. § 120.

Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement between the inventions of Groups I and II. There are two criteria for a proper restriction requirement, namely: 1) the inventions must be independent or distinct; and 2) there must be a serious burden on the Examiner if restriction is not required. Under M.P.E.P. § 808, the Examiner must examine the subject application on the merits even though it includes claims

to distinct inventions, if the search and examination of the application can be made without serious burden. Applicant submits that a search of the art for references related to the subject matter of the claims of Group I may likely uncover references related to the subject matter of Group II, and therefore the Examiner will not be seriously burdened.

**Rejection Under 35 U.S.C. § 112, 2nd paragraph**

In paragraph 5 of the Office Action, the Examiner rejects claims 3-5 and 14-17 as being indefinite. Specifically, the Examiner states:

"The language of claim 3 is awkward and confusing. If it [sic] unclear how the lip is opposed to the base when it is clearly shown in the drawing figures and set forth in claim 1 to be an extension of the base. There is no structure set forth in the claims to allow for deformation of the cup walls without tearing the walls."

In response, Applicant has cancelled claim 3, without prejudice to later prosecution. With regard to the relationship between the lip and the base, Applicant directs the Examiner to FIGS. 1-3 and 6-7, and to paragraphs 0023, 0027 and 0029, and invites the Examiner to re-read claim 1, which does not recite a lip (which is recited in claims 4-5). A review of the cited figures shows the lip intermediately located on the adaptor, and as described in paragraph 0023: "Formed in the cap 10, at the upper portion of the base 20 and the threads 22 is a recess 32 formed by a top wall 36 and an interior side wall 38 and an exterior lip 34. The lip 34 extends around the periphery of the cap." Thus, the lip 34 is simply and clearly described and illustrated as an element of the adaptor. The specification does not state that the lip is an extension of the base.

In response to the Examiner's rejection of claims 14-17, Applicant has amended claim 14 to in response to the indefiniteness rejection, and to impart precision into the claims by more

particularly pointing out the invention. The claim amendment has not been drafted to overcome any prior art.

In view of the above, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

### **Rejection Under 35 U.S.C. § 102**

Pending claims 1, 3-5, 9 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,050,759 ("Marble"). As discussed below, Applicant respectfully traverses this rejection.

As claim 3 has been cancelled without prejudice to later prosecution, the rejection of this claim is now moot.

#### **A. The Law of Anticipation and Enabling Prior Art References**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Id.*

However, Applicant submits that claim 1 has elements that cannot be found, either expressly or inherently, in Marble. Moreover, the Examiner admits that Marble fails to teach all of the elements found in Applicant's claim 1. In paragraph 9 of the Office Action, the Examiner states: "Wherein the recess of Marble is not considered to be "sized to engage" a bead of an associated cup during usage. . . " thereby conceding that Marble does not teach elements recited in Applicant's claim 1.

To be clear, claim 1 recites, in part:

" . . . an annular base depending from the cap and having threads on an exterior surface of the base, **the base having a recess sized to engage the bead of the cup. . .**" (emphasis added)

Marble has no teaching or suggestion of a base having a recess sized to engage the bead of a cup, as recited in claim 1. Instead, Marble teaches an infant drinking cup that, as illustrated in FIGS. 2, 3 and 5, has a smooth un-beaded opening, and a lid that has a rim. Specifically, "the lid 20 has a rim 38. A portion 40 of the rim may be slightly flattened." (see FIG. 1 and col. 3, lines 22-24). Marble further teaches his cup having "a wall 48 extends longitudinally upward from the base 46 to an open end. The open end is adapted to receive a lid 52" (col. 3, lines 42-44). As shown in Marble's figures, the cup has smooth sides that end in a bead-less opening, with the lid including a thread that engages an existing thread in the cup. Clearly, Marble's bead-less cup and rimmed lid fails to teach all of the elements recited in Applicant's independent claim 1.

Regarding Applicant's independent claim 18, which recites, in part:

"...an annular base depending from the cap and having threads on an exterior surface of the base, the threads formed on an insert fastened to the base and made of a softer material than the base."

Marble contains no teaching or suggestion of a cap having a base made of a material softer than the cap.

In view of the above, Applicant respectfully submits that the above discussion has traversed the rejection of independent claims 1 and 18. Because claims 4-5 and 9 depend from claim 1, it is respectfully submitted that the rejection of claims 4-5 and 9 have been traversed by virtue of their dependency from claim 1. M.P.E.P. § 2143.03.

#### **1<sup>st</sup> Rejection Under 35 U.S.C. § 103(a)**

In paragraph 9 of the Office Action, claims 1 and 3-11 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Marble in view of U.S. Patent 5,036,993 ("Ramsey"). Applicant respectfully traverses this rejection.

As claim 3 has been cancelled without prejudice to later prosecution, the rejection of this claim is now moot.

**A. The Law of Obviousness**

In order to establish a prima facie case of obviousness, three basic criteria must be met:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure." M.P.E.P. § 2142.

The shortcomings of Marble, specifically Marble's failure to teach all of the elements found in Applicant's independent claim 1, have been discussed above.

However, Ramsey does not supply the features lacking in Marble. For example, Applicant's independent claim 1, recites, in part:

**". . .an annular base depending from the cap and having threads on an exterior surface of the base, the base having a recess sized to engage the bead of the cup, the base and threads being sized to threadingly engage the walls of the cup thereby deforming the walls of the cup."**

Ramsey, nor Marble teach a base having threads that are sized to threadingly engage the walls of the cup thereby deforming the walls of the cup.

In fact, Ramsey is virtually silent as to exactly how his closure 10 is attached to his cylindrical receptacle 14, and only states: "closure 10 is shown as being removeably attached to receptacle 14," and later: "closure 10. . . is adapted to be removeably attached to the substantially cylindrical receptacle 14" (col. 2, lines 45-50). Ramsey does not illustrate, teach or suggest any type of threading engagement between his closure 10 and his cylindrical receptacle 14.

In view of the above, Applicant respectfully submits that the above discussion has traversed the rejection of independent claim 1. Because claims 4-11 depend from claim 1, it is respectfully submitted that the rejection of claims 4-11 have been traversed by virtue of their dependency from claim 1. M.P.E.P. § 2143.03.

### **2nd Rejection Under 35 U.S.C. § 103(a)**

In paragraphs 10 and 11 of the Office Action, claims 12-13 and 19 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Marble in view of U.S. Patent 6,752,287 ("Lin"). Applicant respectfully traverses this rejection.

Because claims 12-13 and 19 depend from independent claims 1, and 18, respectively, and these independent claims have been distinguished from Marble above, it is respectfully submitted that the rejection of claims 12-13 and 19 have been traversed by virtue of their dependency from claims 1 and 18, respectively. M.P.E.P. § 2143.03.

### **3rd Rejection Under 35 U.S.C. § 103(a)**

In paragraph 12 of the Office Action, claims 1, 3-11 and 13 stand rejected as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent 5,529,202 ("Shamis") in view of U.S. Patent 6,745,915 ("Rees"). Applicant respectfully traverses this rejection.

As claim 3 has been cancelled without prejudice to later prosecution, the rejection of this claim is now moot.

Shamis teaches a lug-and-latch engagement system that is bead-less and thread-less: "A closure for a container has a lid combining positively interengaging latches with a biasing feature which urges the lid upward with respect to the container in order to more firmly effect latching" (Abstract). As shown in FIGS. 1 and 2, Shamis teaches "a series of lugs 16 are formed on the

surface of the interior wall 17 of container 12. . .lugs are preferably formed as trapezoids or right triangles" (col. 6, lines 8-11).

Rees also teaches a drinking vessel that it bead-less and thread-less. Rees teaches a "cover 14 includes inner and outer downwardly projecting skirts 16, 18. . .defining an annular groove 20 between them which receives the top of the sidewall of the vessel body 12" (col. 2, lines 18-21). The Examiner's assertion that "Rees teaches it is known to provide a cup having a rounded recess on the base for engaging a cup lip having a bead thereon" is erroneous. Rees cup has no bead, nor is Rees' base "rounded." Instead, it comprises two "downwardly projecting skirts 16, 18."

Because neither Shamis nor Rees teach or suggest the elements recited in Applicant's independent claim 1, Applicant respectfully submits that the above discussion has traversed the rejection of independent claim 1. Because claims 4-11 and 13 depend from claim 1, it is respectfully submitted that the rejection of claims 4-11 and 13 have been traversed by virtue of their dependency from claim 1. M.P.E.P. § 2143.03.

#### **4th Rejection Under 35 U.S.C. § 103(a)**

In paragraphs 13 of the Office Action, claim 2 stands rejected as unpatentable under 35 U.S.C. § 103(a) over Marble in view of U.S. Design Patent 476,849 ("Randolph"). Applicant respectfully traverses this rejection.

Because claim 12 depends from independent claims 1, and this independent claim has been distinguished from Marble above, it is respectfully submitted that the rejection of claim 12 has been traversed by virtue of its dependency from claim 1. M.P.E.P. § 2143.03.

### **5<sup>th</sup> Rejection Under 35 U.S.C. § 103(a)**

In paragraph 14 of the Office Action, claims 1, 12 and 12 [sic] stand rejected as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent 4,574,970 ("Schwarz") in view of U.S. Patent 494,361 ("Bonwick"). Applicant respectfully traverses this rejection.

As discussed above, Applicant's independent claim 1 recites, in part:

" . . . an annular base depending from the cap and having threads on an exterior surface of the base, the base having a recess sized to engage the bead of the cup. . . "

However, neither Schwarz nor Bonwick teach or suggest a base having threads, nor a base having a recess sized to engage the bead of a cup.

Instead, Schwarz teaches a cap for drinking cups that has a "downwardly extending peripheral wall 14, the lower edge of which being stepped for being insertable into the cup (not shown)" (col. 2, lines 30-32). Thus, Schwarz simply slides his cap into the drinking cup. No threads are illustrated, taught or suggested in Schwarz, and Bonwick, which teaches a stopper for bottles, is also completely silent as to threads or recesses sized to engage the bead of a cup.

In view of the above, Applicant respectfully submits that the above discussion has traversed the rejection of independent claim 1. Because claim 12 depends from claim 1, it is respectfully submitted that the rejection of claim 12 has been traversed by virtue of its dependency from claim 1. M.P.E.P. § 2143.03.

### **6<sup>th</sup> Rejection Under 35 U.S.C. § 103(a)**

In paragraph 15 of the Office Action, claims 1 and 6-9 stand rejected as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent 4,810,245 ("Aagesen"). Applicant respectfully traverses this rejection.

In support of the rejection, the Examiner states:



"Aagesen teaches the claimed cap except for the threads on the base. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize threads on the base of Aagesen since the examiner takes Official Notice of the equivalence of threads and threadless, frictional engagement for their use in the closure are and the selection of any of these known equivalents to secure a cap to a cup would be within the level of ordinary skill in the art."

Applicant respectfully traverses the Examiner's assertion and Official Notice that threads are equivalent to threadless, frictional engagement. The Examiner has provided no reference to support his assertion that threads and threadless, frictional engagement are equivalent.

If the Examiner maintains this rejection, Applicant respectfully requests that the Examiner provide a specific reference teaching that threads and threadless, frictional engagement are equivalent. M.P.E.P. §2144.03

Moreover, Aagesen fails to teach an adaptor for cup having a bead, the adaptor having a cap with a base having a recess sized to engage the bead of the cup, as recited in Applicant's independent claim 1.

Instead, Aagesen is completely silent as to the features of the cup, or how the cover 4 engages with the cup, and only states: "Said cup is closed by a cover 4 with a spout for drinking" (col. 1, lines 49-51).

In view of the above, Applicant respectfully submits that the above discussion has traversed the rejection of independent claim 1. Because claims 6-9 depend from claim 1, it is respectfully submitted that the rejection of claims 6-9 have been traversed by virtue of their dependency from claim 1. M.P.E.P. § 2143.03.

**Change of Correspondence Address**

Accompanying this Response to Office Action are PTO forms SB/81 and SB/82, each designating a Change of Correspondence Address. Please change the correspondence address to:

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The attorney of record can be reached by phone at: 858.449.0612

**Conclusion**

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of claims 1-2 and 4-18 at an early date is solicited. No fee is believed due with this response. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

October 19, 2005  
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Date

  
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